

REMARKS

Applicants acknowledge receipt of the Examiner's Office Action dated May 22, 2006.

This Office Action rejected all pending claims. Specifically, independent claim 17 was rejected under 37 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,321, 298 issued to Hubis ("Hubis"). Claims 1, 5, 9, 13, 14, and 18 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, and 12 of U.S. Patent No. 7,028,156 issued to Kiselev et al. ("Kiselev") in view of U.S. Patent Application Publication No. US 2004/0205298 filed by Bearden et al. ("Bearden"). Claims 1-6, 9-11, 13, and 18 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-4, 8, 14-17, and 23 of copending Application No. 10/742,129 ("the '129 Application") in view of Bearden. Lastly, claims 1, 5, 6, 9, and 18 were provisionally rejected on the ground of nonstatutory double patenting over claims 24, 25, 32, and 41 of copending Application No. 11/242,216 ("the '216 Application"). The Office Action indicated, with thanks, that claims 1-16, and 18 would be allowable over the prior art if the double patenting or provisional double patenting rejections were overcome. In light of the following remarks, Applicants respectfully request the Examiner's reconsideration and reexamination of all pending claims.

Independent claim 17 was rejected under 35 U.S.C. § 102 as being anticipated by Hubis. Applicants have cancelled claim 17 without prejudice. Applicants reserve the right to prosecute independent claim 17 in a continuation application.

Claims 1, 5, 9, 13, 14, and 18 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, and 12 of Kiselev in view of Bearden. In this rejection, the Office Action asserts that most of the limitations of independent claims 1, 9, and 18 can be found in Kiselev. The Office Action admits that "returning data

stored in the cache memory in response to receiving the second request” of independent claims 1, 9, and 18 is not found in Kiselev. The Office Action then asserts that this missing limitation can be found in Bearden. According to the Office Action, it would have been obvious to combine Bearden with Kiselev to obtain the invention as specified in independent claim 1, 9, and 18.

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but one examined application claim is not patentably distinct from the reference claim or claims because the examined application claim is either anticipated by or would have been obvious over, the reference claim or claims. See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998). This cited section of *In re Berg* makes clear that a nonstatutory obviousness-type double patenting rejection is based upon the claim or claims of one reference. The Office Action rejects independent claims 1, 9, and 18 based upon two references. As such, Applicants assert that the nonstatutory obviousness-type double patenting rejection of independent claims 1, 9, and 18, is improper.

Independent claims 1-6, 9-11, 13, and 18 were provisionally rejected on the ground of nonstatutory double patenting over claims 1-4, 8, 14-17, and 23 of the ‘129 Application in view of Bearden. Applicants submit that this rejection is improper for the same reasons set forth above. Namely, since *In re Berg* makes clear that a nonstatutory obviousness-type double patenting rejection is based upon the claim or claims of one reference, and since the Office Action rejects claims 1-6, 9-11, 13, and 18 based upon two references, Applicants assert that the nonstatutory obviousness-type double patenting rejection of claims 1-6, 9-11, 13, and 18 is improper.

Claims 1, 5, 6, 9, and 18 were provisionally rejected on the ground of nonstatutory double patenting over claims 24, 25, 32, and 41 of Application ‘216. With respect to claim 1, the

Office Action asserts that all limitations of independent claim 1 are recited in claim 24 of the '216 Application. Claim 24 of the '216 Application is dependent upon claim 22 of the '216 patent application. Claim 22 of the '216 patent application, in turn, recites "comparing the data read from the first memory with the data read from the second memory," which is not taught or fairly suggested in independent claim 1 set forth above. As such, Applicants submit that independent claim 1 is patentably distinct over claim 24 of the '216 patent application.


The Office Action similarly asserts that all limitations of independent claim 9 are recited in claim 32 of the '216 application. Claim 32 of the '216 patent application is dependent upon claim 30 of the '216 patent application. Claim 30 '216 patent application recites "comparing the data read from the first memory with the data read from the second memory," which is not taught or fairly suggested independent claim 9. As such, independent claim 9 is patentably distinct over claim 32 of the '216 patent application.

The Office Action asserts that all limitations of independent claim 18 are recited in claim 40 of the '216 application. Claim 40 of the '216 application is dependent from claim 39 of the '216 patent application. Claim 39 of the '216 patent application recites "comparing the data read from the first memory with the data read from the second memory," which is not taught or fairly suggested in independent claim 18 set forth above. As such, Applicants submit that independent claim 18 is patentably distinguishable over claim 40 of the '216 application.

CONCLUSION

Applicants submit that all claims are now in condition for allowance, and an early notice to that effect is earnestly solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is requested to telephone the undersigned.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia, 22313-1450, on June 30, 2006.

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Attorney for Applicant(s) Date of Signature

Respectfully submitted,



Eric A. Stephenson
Attorney for Applicant(s)
Reg. No. 38,321
Telephone: (512) 439-5093
Facsimile: (512) 439-5099